

Appl. No. 10/676,397
Docket No. 9047MQ
Amdt. dated July 11, 2006
Customer No. 27752

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REMARKS

Claim Status

Claims 1-8 are pending in the present application. No additional claims fee is believed to be due.

Claims 9-16 have been withdrawn as a result of an earlier restriction requirement.

Claims 1-3 have been amended to claim xylan levels that are added to the furnish. Support for the amendment is found at page 6, lines 5-8 of the specification.

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

Rejection Under 35 USC §112, First Paragraph

Claims 1-8 were previously rejected under 35 USC §112, first paragraph, on the grounds that the claimed amounts of xylan in the web have not been taught by the specification. (Office Action dated April 18, 2006, p. 3). The test of whether there has been sufficient enablement is whether one of skill in the art can make and use the invention without undue experimentation. *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). It is well established that not everything necessary to practice the invention need be disclosed. In fact, what is well known is best omitted. *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991); MPEP §2164.08.

The Applicants respectfully submit that the *prima facie* case of non-enablement has not been met because the Applicants specifically disclose the addition of the claimed amounts of xylan. (Specification, page 6, lines 5-8). In addition, Applicants have provided detailed examples (Specification, p. 9-11) directing persons of ordinary skill in the art to make the Applicants' claimed invention (including starting materials and necessary apparatus). Doing so is consistent with the principle that if the specification discloses at least one method for making and using the claimed invention that bears a

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reasonable correlation to the entire scope of the claim, the enablement requirement of 35 USC 112 is satisfied. *In re Fisher*, 427 F.2d 833, 839, 166 USPQ 18, 24 (CCPA 1970); MPEP §2164.01(b).

Applicants respectfully assert that there is ample enablement for the claims as one of ordinary skill in the art could easily practice the claimed invention given the disclosure in the specification. Consequently, Applicants respectfully request withdrawal of the 35 USC §112 rejection.

Rejection Under 35 USC §103(a) Over US 5,810,972

Claims 1-8 were previously rejected under 35 USC §103(a) as being unpatentable over US 5,810,972 (hereinafter "Reinheimer"). This rejection is traversed on the grounds that Reinheimer does not teach or suggest all of the claim limitations in Claim 1 (of which Claims 2-8 are dependent). Specifically, Reinheimer fails to teach the Applicants' claimed limitation that the paper product contain xylan in the amount of from about 0.005% to about 0.1% by weight of cellulose, nor does Reinheimer teach why one of ordinary skill in the art would modify its teachings to arrive at the Applicants' claimed invention. The Office Action dated April 18, 2006 states that the range limits claimed in the present invention are within the "acceptable error" limit in papermaking operation[s]." (Office Action dated April 18, 2006, p. 3). However, the Office Action has failed to provide an adequate basis as to what an "acceptable" error limit in papermaking is and has not established a basis for why one of ordinary skill in the art would be motivated to modify Reinheimer to arrive at the Applicants' claimed invention.

One of ordinary skill in the art would not be inclined to take the Reinheimer teaching and arrive at the Applicants' claimed invention. Reinheimer teaches the addition of 0.15% to 1.5% of xylan to the pulp. (Reinheimer, col. 4, lines 12-26). Further, Reinheimer teaches that too little xylan in the pulp will lead to decreased rupture strength, increased dryer pressure, and a decrease in the runnability and coating film properties. (Reinheimer, col. 3, lines 52-64). Reinheimer specifically states that high rupture strength, decreased dryer pressure, and increased runnability and coating film properties are desired. (Reinheimer, col. 2, lines 32-49). In order to modify or combine references, there must be some motivation directed to what is desirable, rather than what is merely feasible. *Winner International Royalty Corp. v. Wang*, 202 F.3d 1340, 53 USPQ2d 1580 (Fed. Cir., 2000). Here, to modify the teachings (0.15% to 1.5% of xylan) to arrive at the

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claimed invention (from about 0.005% to about 0.1% xylan -- a difference of 50%) is merely feasible but runs contrary to obtaining the benefits taught by Reinheimer. Thus, there is no actual motivation to modify the Reinheimer teaching to arrive at the Applicants' claimed invention.

Therefore, Reinheimer does not suggest or motivate one of ordinary skill in the art to utilize the claimed range of from about 0.005% to about 0.1% of xylan, based on the disclosure of the higher xylan ranges taught in Reinheimer. Applicants respectfully request removal of the obviousness rejection.

Conclusion


In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejection under 35 USC §103(a).

This response represents an earnest effort to place the application in proper form and to distinguish the invention as now claimed from the applied reference. In view of the foregoing, reconsideration of this application and allowance of Claims 1-8 are respectfully requested.

Respectfully submitted,

THE PROCTER & GAMBLE COMPANY

By


Signature

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